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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,478	01/11/2001	Dale C. Gledhill	03411.006	9341
22913	7590	04/14/2004	EXAMINER	
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			CHIANG, JACK	
		ART UNIT	PAPER NUMBER	
		2642	10	
DATE MAILED: 04/14/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	09/758 478	Applicant(s)	D. Gledhill
Examiner	J. Chiang	Group Art Unit	2642
			# 1D

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

Responsive to communication(s) filed on 12/1/03 + 1/12/04.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

### Disposition of Claims

Claim(s) 1-19 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-19 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413

Notice of References Cited, PTO-892  Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

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**NOTE:** to assist applicant to read the Russo reference (US 4817139), the examiner has labeled two elements as "40" and "42" in Russo's Fig. 3.

### CLAIMS

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 6-7, 14-15, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Russo (US 4817139).

Regarding claim 1, Russo shows a shoulder rest comprising:

A first portion (32) for abutting against a user's shoulder;

Base portions (26, 38, 40, 42) for abutting and adhering (see 28) against a back side of a handset (24);

A cut-out portion (between 40, 42) between the base portions for allowing the shoulder rest to conform to different shaped handsets.

Regarding claim 7, Russo shows a method of making a shoulder rest comprising:

Forming a first portion (32) for abutting against a user's shoulder;

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Forming base portions (26, 38, 40, 42) for abutting and adhering (see 28) against a back side of a handset (24);

Forming a cut-out portion (between 40-42) between the base portions for allowing the shoulder rest to conform to different shaped handsets.

Regarding claim 14, Russo shows a shoulder rest comprising:

A first means (32) for abutting against a user's shoulder;

Base means (26, 38, 40, 42) for abutting and adhering (see 28) against a back side of a handset (24);

A concave means (between 40, 42) between the base means for allowing the shoulder rest to conform to different shaped handsets.

Regarding claims 2, 6, 15, 19, Russo shows:

The curved first portion (32);

The first and base portions (fig. 3) of the shoulder rest are part of a hollow body (between 40, 42) of the shoulder rest.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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4. Claims 3-4, 10-12, 16-17, 5, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo in view of Castle et al. (US 6341163).

Regarding claims 3-4, 10-12, 16-17, 5, 18, Russo shows a shoulder rest (see comments above).

Russo differs from the claimed invention in that it does not show a strap and the claimed shape of the first portion.

However, Castle teaches providing a strap (i.e. 224, 110, 102) between the base portions. Castle further shows the first portion (see 400) narrows along a length from a front end to a narrowest portion and then widens again.

Hence, it would have been obvious for one skilled in the art to modify Russo with a strap and adhesive or Velcro as taught by Castle, such that to reinforce the engagement between the handset and the shoulder rest. Further, the shape of the first portion is a variation of Russo as long as the shoulder rest can be comfortably rested on the user's shoulder.

5. Claims 1-2, 6-7, 14-15, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Sutton (US 4961223) in view of Sutton (US 4759058).

Regarding claim 1, Sutton'223 shows a shoulder rest comprising:

A first portion (10) for abutting against a user's shoulder;

Base portions (17, 18) for abutting against a back side (21 in figs. 2 and 4) of a handset (H);

A cut-out portion (between 17-18) between the base portions for allowing the shoulder rest to conform to different shaped handsets.

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Sutton'223 differs from the claimed invention in that it does not explicitly mention to use an adhesive when mounting the handset.

However, Sutton'058 teaches providing a base portions (54) for abutting and adhering (see 57) against a back side of a handset (5).

Hence, the concept of mounting the shoulder rest with the handset is well taught by both Sutton, it would have been obvious for one skilled in the art to modify Sutton'223 with an adhesive as taught by Sutton'058, this simply can be considered as an reenforcement of the Sutton'223 as it is taught from the family of patens shown by Sutton.

Regarding claim 7, Sutton shows a method of making a shoulder rest comprising:

Forming a first portion (10) for abutting against a user's shoulder;

Forming base portions (17-18) for abutting against a back side (21 in figs. 2 and 4) of a handset (H);

Forming a cut-out portion (between 17-18) between the base portions for allowing the shoulder rest to conform to different shaped handsets.

Sutton'223 differs from the claimed invention in that it does not explicitly mention to use an adhesive when mounting the handset.

However, Sutton'058 teaches providing a base portions (54) for abutting and adhering (see 57) against a back side of a handset (5).

Hence, the concept of mounting the shoulder rest with the handset is well taught by both Sutton, it would have been obvious for one skilled in the art to modify Sutton'223

with an adhesive as taught by Sutton'058, this simply can be considered as an reenforcement of the Sutton'223 as it is taught from the family of patens shown by Sutton.

Regarding claim 14, Sutton shows a shoulder rest comprising:

A first means (10) for abutting against a user's shoulder;  
Base means (17-18) for abutting against a back side (21 in figs. 2 and 4) of a handset (H);  
A concave means (between 17-18) between the base means for allowing the shoulder rest to conform to different shaped handsets.

Sutton'223 differs from the claimed invention in that it does not explicitly mention to use an adhesive when mounting the handset.

However, Sutton'058 teaches providing a base portions (54) for abutting and adhering (see 57) against a back side of a handset (5).

Hence, the concept of mounting the shoulder rest with the handset is well taught by both Sutton, it would have been obvious for one skilled in the art to modify Sutton'223 with an adhesive as taught by Sutton'058, this simply can be considered as an reenforcement of the Sutton'223 as it is taught from the family of patens shown by Sutton.

Regarding claims 2, 6, 15, 19, Sutton shows:

The curved first portion (10);

The first and base portions (fig. 1) of the shoulder rest are part of a hollow body (between 17-18) of the shoulder rest.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 3-4, 10-12, 16-17, 5, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sutton'223 and Sutton'058 in view of Castle et al. (US 6341163).

Regarding claims 3-4, 10-12, 16-17, 5, 18, the combination of Sutton shows a shoulder rest (see comments above).

Sutton differs from the claimed invention in that it does not show a strap and the claimed shape of the first portion.

However, Castle teaches providing a strap (i.e. 224, 110, 102) between the base portions. Castle further shows the first portion (see 400) narrows along a length from a front end to a narrowest portion and then widens again.

Hence, it would have been obvious for one skilled in the art to modify Sutton with a strap and adhesive or Velcro as taught by Castle, such that to reinforce the engagement between the handset and the shoulder rest. Further, the shape of the first portion is a variation of Sutton as long as the shoulder rest can be comfortably rested on the user's shoulder.

### ARGUMENT

8. In response to the remarks (filed on 12-01-03), on page 4, applicant first argues that ... Sutton' 223 ... rather than conform to differently shaped telephone handsets, its invention "is intended for use with a standard basically parallepedal handset .... First, the examiner agrees with applicant that Sutton'223 can be used with a standard basically parellepipetal handset. Second, Sutton'223 can also be used with a cellular-telephone handset (col. 1, lines 60-62). With the adjustability of the bases (clips 17-18), Sutton'223 can be used with most of the handsets in the market today.

On pages 4 and page 5, applicant argues about "a fundamental difference", such as screws vs adhesive. The examiner disagrees. From the family of patens shown by Sutton, it is clear that adhesive is used to reenforce the mounting of the handset.

On page 5, applicant argues that Sutton' 223 is for use on cellular telephones.... It is simply not designed to be able to conform to curved handsets... he was simply unable to solve the problem of creating a shoulder rest capable of conforming to almost any shaped telephones.... The examiner disagrees. First, the examiner likes to ask: are all cellular telephones in one single shape? Second, if applicant acknowledges that Sutton'223 is for use on cellular telephones, then it means substantially all today's cellular telephones can be used with Sutton'223, and cellular telephones in today's market have many design and shapes. Third, curved handsets are not even an issue here.

In pages 5-6, applicant argues about the strap, this issue has been discussed in the rejection above, see comments above. Applicant again argues that use of adhesive

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in conjunction with Sutton' 223 would destroy the ability of the user to release the shoulder rest from the cellular telephone ... increase the size and inconvenience of the Sutton'223 device. The examiner would provide the following comments. First, from the family of patent shown by Sutton, at least one Sutton patent uses adhesive. In other words, one skilled in the art understood the result of using the adhesive. Second, when a shoulder rest is mounted onto a handset, such as in an office, how often the user needs to remove the shoulder rest from the handset. Take the examiner as an example, if a shoulder rest have been mounted with the examiner handset, regardless how the shoulder rest is mounted with the handset, it would have been remaining the same for more than a decade. The point is whatever means is used to mount the shoulder rest and the handset, whether it is Velcro, adhesive, screws, or straps, the result is expected and well known for one skilled in the art.

9. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

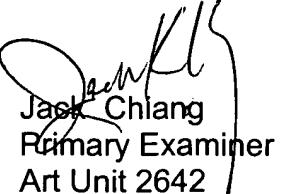
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack Chiang  
Primary Examiner  
Art Unit 2642